

Serial No. 10/758,627
Amendment Dated December 8, 2004
Reply to Office Action of November 30, 2004

While the '220 patent does teach a first drive means that rotates the boring bar and the cutting head about the longitudinal axis of the boring bar, the second drive means only has the ability to translate the cutting head member along the boring bar and there is no control means that can be engaged to selectively either longitudinally translate the cutting head member axially along the boring bar member while inhibiting radial movement of the slide and tool bit or radially translating the slide and tool bit of the annular cutting head member with respect to the longitudinal axis of the boring bar member while inhibiting axial translation of the cutting head member. Only the present application teaches that mechanism.

In that the '220 patent does not disclose a second drive means that is selectively operable to either translate the cutting head member along the boring bar or to impart translation of the tool slide in a radial direction with respect to the longitudinal axis of the boring bar, but not both simultaneously, claims of a scope corresponding to independent claims 1 and 10 could not have been earlier presented in the prosecution of the application leading to the '220 patent. Accordingly, the double patenting rejection should be withdrawn.

The rejection of claims 1, 3-5, 7 and 10 is under 35 U.S.C. §102(b) is also traversed. To anticipate a claim under 35 U.S.C. §102(b), a reference must disclose every element of the claim; if there are differences between the reference disclosures and the claim, the rejection must be based on obviousness. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985). While the Examiner lists "some of the claimed elements clearly disclosed by the (Marron) reference, that listing does not include the "control means for selectively ... cutting head member" recited as part of element (e) of independent claim 1 nor the "second drive means selectively operable ... boring bar" of element (c) of independent claim 10. As such, the rejection based on 35 U.S.C. §102(b) of claims 1, 3-5, 7 and 10 is improper and must be withdrawn.

Dependent claims 2 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Marron reference. Claims 2 and 6 are dependent claims further defining and restricting independent claim 1. As pointed out above, the Marron reference

Serial No. 10/758,627
Amendment Dated December 8, 2004
Reply to Office Action of November 30, 2004

is entirely lacking in any teaching of a second drive means including control means for selectively longitudinally translating the cutting head member along the boring bar while at the same time inhibiting radial movement of the slide and tool bit or radially translating the slide and tool bit while inhibiting axial translation of the cutting head member. Absent such a teaching in independent claim 1, the invention defined by dependent claims 2 and 6 cannot be considered obvious within the meaning of 35 U.S.C. §103(a).

Under the section entitled "Response to Arguments" set out on page 4 of the Final Action of November 30, 2004, the Examiner asserts that the control means for selectively longitudinally translating the cutting head member along the boring bar member or radially translating the slide and tool bit with respect to the longitudinal axis of the boring bar member are not recited in the rejected claims (emphasis in the original). The Examiner's statement is not understood. Looking at the "Listing of Claims" set out in Applicants' Amendment of September 10, 2004, those exact words are set out in element (e) of independent claim 1 *in haec verba*.

Applicants' attorney would also point out that element (e) of claim 1 is written in "means-plus-function" manner authorized by 35 U.S.C. §112, para. 6 such that it includes the means set out in the specification for performing the stated function and equivalents thereof. In this respect, claims are to be interpreted in light of the specification and limitations from the specification are necessarily imported into the claims.

Applicants' attorney has carefully considered the Marron '041 reference at column 4, lines 56-68, and column 5, lines 1-11, and it is submitted that this material does not teach or suggest applicants' control means that allows a second drive means, e.g., a motor plus control, that allows selective longitudinal movement of the cutting head along the bar or radial movement of the slide and tool bit, but not both simultaneously. The Marron arrangement requires separate drives for the axial translation and the radial movement. Specifically, turning the crank 211 and the screw 38 moves the cutting head member 35 longitudinally and a separate drive connected to the screw 66 is needed to radially move the tool bit 56. Further, both the screw 38 and the screw 66 can be turned simultaneously. As the Examiner must now appreciate, in applicants' arrangement, a

Serial No. 10/758,627
Amendment Dated December 8, 2004
Reply to Office Action of November 30, 2004

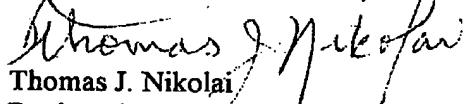
single drive can be controlled to independently longitudinally translate the cutting head assembly and to radially translate the slide and cutting bit.

For the reasons presented, then, it is believed that the claims in the application do not improperly extend the "right to exclude" provided by U.S. Patent 6,447,220, and since there is no support in the '220 for the claimed subject matter of the instant application, claims to the present invention could not have been embodied in the '220 patent. Thus, the double patenting rejection must be withdrawn.

Further, it has been shown that the claims in the application are neither anticipated by or rendered obvious in view of the Marron patent and, accordingly, the application is now in condition for allowance and a Notice to that effect is respectfully solicited.

Respectfully submitted,

NIKOLAI & MERSEREAU, P.A.


Thomas J. Nikolai
Registration No. 19,283
900 Second Avenue South, Suite 820
Minneapolis, MN 55402-3325
Telephone: 612-339-7461
Fax: 612-349-6556

Serial No. 10/758,627
Amendment Dated December 8, 2004
Reply to Office Action of November 30, 2004

CERTIFICATE OF MAILING

I hereby certify that the foregoing in response to the Final Official Action of November 30, 2004, in application Serial No. 10/758,627, filed on January 15, 2004, of Donato L. Ricci entitled "Radial Feed Facing Head for Boring Bar" is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, postage prepaid, on December 8, 2004.

Date of Signature: December 8, 2004.

Linda J. Rice

On Behalf of Thomas J. Nikolai

Attorney for Applicant(s)

Linda J. Rice